

## **RESPONSE**

### **A. Status of the Claims**

Claims 19-44 were pending at the time of the Restriction Requirement, with claims 1-18 having been canceled in the Preliminary Amendment filed with the application on March 27, 2006. Claim 44 is provisionally withdrawn in view of the election of the Group I invention made below.

Therefore, claims 19-44 are pending, with claims 19-43 currently under consideration.

### **B. Response to Restriction Requirement**

In response to the Restriction Requirement, Applicants elect, *without traverse*, to prosecute the Group I invention, claims 19-43, drawn to a lens.

### **C. Response to Species Election Requirement**

The examiner has also entered a species election requirement with regard to the Group I invention among the following materials for the outer layer set forth in claim 19: metal fluoride, metal oxide, metal hydroxide, marking ink for optical lenses or resin which may form the binding agent of a marking ink. Applicants elect, *with traverse*, metal fluoride as the species. Claims 20-22 and 25-27 read on the elected species.

Applicants traverse the species election requirement on the basis that, under the appropriate rules, the claims should not be restricted to a metal fluoride if no generic claim is finally held to be allowable, but rather to a metal fluoride, metal oxide or metal hydroxide.

Pursuant to MPEP § 1850 and PCT Rule 13.2, metal fluoride, metal oxide and metal hydroxide are alternatives of a similar nature, which therefore meet the requirement of a technical interrelationship and the same or corresponding special technical features as defined in PCT Rule 13.2. These three materials all allow for the formation of temporary coatings capable

of ensuring a good adhesion of the holding pad to the lens surface during the edging process, which leads to a successful edging of the lens, and they belong to a recognized class of chemical compounds in the art to which the invention pertains (metallic derivatives that only differ by the nature of the anion associated to the metallic cation) and represent variants in which a common structure is present, i.e., a significant structural element is shared by all of the three alternatives (the metallic cation).

Accordingly, the claims should not be restricted to a metal fluoride if no generic claim is finally held to be allowable, but rather to a metal fluoride, metal oxide or metal hydroxide.

Regardless of the outcome of Applicants' traversal, Applicants reserve all rights to reintroduce non-elected species in the event of allowance of a generic claim.

#### **D. Rejoinder of Withdrawn Process Claims**

The Action states that the inventions of Group I (claims 19-43) and Group II (claim 44) are related as product and process of use. Pursuant to the statements in the Action, Applicants reserve the right to have claims directed to the process (i.e., the Group II claims) that depend from or otherwise contain all the limitations of the allowable product claims (i.e., the Group I claims) examined in the present case once claims directed to the elected product are found to be allowable.

#### **D. Conclusion**

Applicants believe that they have submitted a complete reply to the Restriction Requirement dated October 21, 2008, and respectfully request favorable consideration of the claims in view of the amendments and statements contained herein.

Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3035.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'MBW', with a large, sweeping flourish extending from the end of the signature.

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